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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,763	10/07/2003	James Daleiden	018367-9798-00	5228
23409	7590	07/06/2005	EXAMINER	
MICHAEL BEST & FRIEDRICH, LLP 100 E WISCONSIN AVENUE MILWAUKEE, WI 53202			PHAM, MINH CHAU THI	
			ART UNIT	PAPER NUMBER
			1724	

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/680,763

Applicant(s)

DALEIDEN, JAMES

Examiner

Minh-Chau T. Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 16, 17, 28 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Ernst et al (6,231,630 B1).

Ernst et al teach an air filter for the intake air of an internal combustion engine comprising a housing (30) defining a filter receiving space therein, a filter (35) and a biasing element or a spring clip (38) integrally formed as one piece with the housing (30) (see 30, 35 and 38 in Fig. 3, col. 3, lines 21-31).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 5-15, 18-27 and 30-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Erdmannsdorfer (4,632,682), Uebelhoer et al (5,429,101) and Kasten (2,413,769).

Erdmannsdorfer discloses an air filter apparatus having a filter housing (30), a filter (43) positioned inside the filter housing and a biasing element or spring (46) pushing the filter element tightly located inside the housing (30) (see Fig. 1). Uebelhoer et al disclose an air filter apparatus having a filter housing (30), a filter (43) positioned inside the filter housing and a biasing element or spring (unlabeled) pushing the filter

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element tightly located inside the housing (30) (see Fig. 2). Kasten discloses a filter apparatus having a filter housing (14), a filter (29) positioned inside the filter housing and a biasing element or spring (34) pushing the filter element tightly located inside the housing (30) (see Fig. 2). Regarding to the limitation "a biasing elements integrally-formed as one piece with the housing" as called for in claims 5-15, 18-27 and 30-40, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a biasing element integrally-formed as one piece with the housing instead of being separated from the housing, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. See Howard v. Detroit Stove Works, 150 U.S. 164 (1893).

Response to Arguments

Applicant's arguments filed on April 11, 2005 have been fully considered but they are not persuasive.

Applicant argues that none of the prior arts discloses "a biasing element is integrally-formed as one piece with the housing and is disposed adjacent the first end". The Examiner now drops both references Anonychuk and Gruber, and newly introduces Ernst et al as the primary reference for the 102 rejection of claims 1-4, 16, 17, 28 and 29 to show an air filter for the intake air of an internal combustion engine comprising a housing (30) defining a filter receiving space therein, a filter (35) and a biasing element or a spring clip (38) integrally formed as one piece with the housing (30) (see 30, 35 and 38 in Fig. 3, col. 3, lines 21-31), as claimed. The Examiner also introduces any one of Erdmannsdorfer (4,632,682), Uebelhoer et al (5,429,101) and Kasten (2,413,769) in the

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103 rejection to show: Erdmannsdorfer discloses an air filter apparatus having a filter housing (30), a filter (43) positioned inside the filter housing and a biasing element or spring (46) pushing the filter element tightly located inside the housing (30) (see Fig. 1). Uebelhoer et al disclose an air filter apparatus having a filter housing (30), a filter (43) positioned inside the filter housing and a biasing element or spring (unlabeled) pushing the filter element tightly located inside the housing (30) (see Fig. 2). Kasten discloses a filter apparatus having a filter housing (14), a filter (29) positioned inside the filter housing and a biasing element or spring (34) pushing the filter element tightly located inside the housing (30) (see Fig. 2). Regarding to the limitation "a biasing elements integrally-formed as one piece with the housing" as called for in claims 5-15, 18-27 and 30-40, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a biasing element integrally-formed as one piece with the housing instead of being separated from the housing, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. See Howard v. Detroit Stove Works, 150 U.S. 164 (1893).

Applicant's arguments with respect to claims 1-40 have been thoroughly considered but are moot in view of the new ground(s) of rejection, as discussed above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh-Chau T. Pham whose telephone number is (571) 272-1163. The examiner can normally be reached on Mon/Tues/Thur/Fri 7:00 am - 5:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Minh-Chau Pham
Patent Examiner
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July 1, 2005